

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

079794.0126

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Signature A. Alfonso E. Juarez

Typed or printed name Alfonso E. Juarez

Application Number

10/525,606

Filed

February 25, 2005

First Named Inventor

Edgar Bolinth et al.

Art Unit

2617

Examiner

Ho, Huy C.

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

- applicant/inventor.
- assignee of record of the entire interest.
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)
- attorney or agent of record. Registration number 60,135
- attorney or agent acting under 37 CFR 1.34.
Registration number if acting under 37 CFR 1.34 _____



Signature

Brian K. Prewitt

Typed or printed name

512.322.2684

Telephone number

June 16, 2009

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required.
Submit multiple forms if more than one signature is required, see below*.

*Total of _____ forms are submitted.

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: Edgar Bolinth *et al.*
Serial No.: 10/525,606
Date Filed: February 25, 2005
Group Art Unit: 2617
Confirmation No.: 7978
Examiner: Ho, Huy C.
Title: **METHOD AND TRANSMISSION DEVICE FOR
TRANSMISSION OF DATA IN A MULTI-
CARRIER SYSTEM**

MAIL STOP – APPEAL
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

PRE-APPEAL REQUEST AND ARGUMENTS

The following Pre-Appeal Brief Request for Review (*Request*) is being filed in accordance with the provisions set forth in the Official Gazette Notice of July 12, 2005 (*OG Notice*). At the time of the Final Office Action mailed March 16, 2009, Claims 10-29 were pending in this Application. Claims 10-29 were rejected. No claim amendments are hereby requested. Pursuant to the *OG Notice*, this *Request* is being filed concurrently with a Notice of Appeal. Applicants respectfully request reconsideration of the Application in light of the remarks set forth below.

ARGUMENTS

As of the mailing of the Final Office Action dated March 16, 2009, the pending Claims stood rejected. Applicants contends that the rejections of Claims 31-60 are not proper for the reasons described in Applicant's Response dated May 18, 2009 at Pages 7-10 (*Applicants' Response*). In short, Applicants contend that, contrary to the Examiner's assertions, the cited references do not teach or suggest, either alone or in combination, each and every element of the recited claims.¹

Rejections under 35 U.S.C. § 103

As set forth in *Applicants' Response*, Applicants respectfully submit that the cited references, separately or as combined by the Examiner, fail to teach or suggest the pending Claims. For example, Independent Claim 10 recites, in part:

performing, on a send side and depending on the transmission characteristic, an adaptive pre-emphasis of a send signal for only a part of the carrier frequencies of the at least one sub-carrier band thereby reducing inter channel interference caused by at least two subscribers, wherein the carrier frequencies which are subject to the adaptive pre-emphasis are only frequencies located at an edge of the at least one sub-carrier band.

Independent Claim 20 recites a similar element. Applicants submit that at least these elements are missing in the cited references.

Independent Claims 10 and 20 are Allowable

Independent Claims 10 and 20 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over *Gudmundson, Ramesh, and Heinonen*. As noted in *Applicants' Response*, *Gudmundson* fails to teach or suggest the above-recited element. See Page 8 of *Applicants' Response*. The Examiner responded to Applicants' Response by citing again portions of *Gudmundson* that discloses an OFDM system and an OFDM signal being treated by a pulse shaping function before transmitting the signal on a subcarrier of the OFDM frequency to reduce the intersymbol interference. See Continuation Sheet of the Advisory Action. The

¹ It is noted in the OG Notice at <http://www.uspto.gov/web/offices/com/sol/og/2005/week28/patbref.htm> that "Applicants are encouraged to refer to arguments already of record rather than repeating them in the request." Accordingly, Applicant refers hereto, and summarizes, the previous arguments rather than reciting them explicitly.

Examiner further concludes, without evidence, that based on the relied upon section, *Gudmundson* discloses "...performing an adaptive pre-emphasis for a send signal by a filter a part of the carrier frequencies in the subcarrier band." However, as indicated in *Applicants' Response*, in reviewing the relied upon sections, *Gudmundson* fails to teach or suggest adaptive pre-emphasis of a send signal for only a part of the carrier frequencies of the at least one sub-carrier band, as recited in Independent Claim 10 and similarly recited in Independent Claim 20. For example, referring to the Detailed Description of the Invention Section beginning on Column 4, Line 60 through Column 6, Line 55 (as relied upon by the Examiner), *Gudmundson* makes no disclosure of that the pulse-shaping of an OFDM signal $x(t)$ is for only a part of the carrier frequencies.

Ramesh and *Heinonen* also fail to teach or suggest the above-recited element of Independent Claim 10 and the similarly recited element of Independent Claim 20. *See* Page 9 in *Applicants' Response*.

Further, in *Applicants' Response*, Applicants submit that the Examiner has failed to show findings of obviousness when a modification can be made, as outlined by, for example, 37 C.F.R. § 1.104(c)(2); M.P.E.P. § 2144.03(C) (*e.g.*, references of record, declarations of those with ordinary skill in the art, *etc.*). However, the Examiner has failed to address this issue in the Examiner's Response, and again, provides unsupported conclusions for making the proposed combination. *See* Continuation Sheet of the Advisory Action. Applicants submit the key to supporting any rejection under 35 U.S.C. [§] 103 is the *clear articulation of the reason(s) why the claimed invention would have been obvious.*" M.P.E.P. § 2143 (emphasis added). The M.P.E.P. also states that "the analysis supporting a rejection under 35 U.S.C. [§] 103 should be *made explicit*. *Id.* (emphasis added). M.P.E.P. § 2143 also sets forth a host of exemplary rationales and Examiner may employ in maintaining a rejection, including particular findings of fact required to support each such rationale. In the present case, the Examiner has not made any such rationale explicit, has not supported the rejection using any rationale set forth in M.P.E.P. § 2143 or other suitable rationale, and has not made any factual findings to support any such rationale.

For at least these reasons, the cited references, either separately or as combined by the Examiner, fail to disclose each and every limitation of Independent Claims 10 and 20.

Accordingly, Applicants respectfully request reconsideration and withdrawal of the rejection under § 103(a) and full allowance of Claims 10 and 20 and their respective dependent claims.

Correction to the Advisory Action

Applicants submit that there were no amendments presented in the Claims or Specification in *Applicants' Response*, as erroneously noted in Part 7 of the Advisory Action mailed May 29, 2009. *See the Listing of Claims on Pages 2-6 of Applicants' Response.* Therefore, no amendments need to be entered for purposes of appeal.

CONCLUSION

Applicants submit these Arguments in Support of Pre-Appeal Brief Request for Review along with a Notice of Appeal. Applicants authorize the Commissioner to charge Deposit Account No. 50-2148 in the amount of \$540.00 for the Notice of Appeal.

Applicants believe there are no further fees due at this time, however, the Commissioner is hereby authorized to charge any additional fees necessary or credit any overpayments to Deposit Account No. 50-2148 of Baker Botts L.L.P.

If there are any matters concerning this Application that may be cleared up in a telephone conversation, please contact Applicants' attorney at 512.322.2684.

SEND CORRESPONDENCE TO:
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Respectfully submitted,
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Date: June 16, 2009